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09/809,631	03/16/2001	Jung-wan Ko	1293.1184	5024

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EXAMINER

LE, DAVID Q

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/809,631

Applicant(s)

KO ET AL.

Examiner

David Q Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

1. The Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claims, other passages and figures apply as well. It is requested from the Applicant, in preparing the response, to consider fully the entire references as well as the context of all passages in the cited references as potentially teaching all or part of the claimed inventions.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-41** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Uranaka** in view of **Toyama**, US Patent No. 5,937,158 and JP Patent No. JP407295998A, respectively.

As per **claims 1, 5, 16, 26, and 34**

Uranaka discloses

[a medium with instructions for recording/reproducing; method / system of purchasing using a catalog recorded on a medium] (Abstract, Fig 1-3, associated text), comprising:

[a medium with] a read-only area in which original commodity catalog information is written (Fig 1-2: "media-utilizing information"; Fig 12-14; C17, L17-31; associated text); and  
a writeable area (Fig 1-2, 12-13, associated text);  
accessing a server with corresponding catalog information (Fig 3, associated text);  
receiving a request for access by a computer using the medium to the catalog information (Fig 3, associated text);

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checking whether updated catalog information is on the server; and transmitting the updated commodity catalog information (Fig 5, associated text).

Uranaka does not disclose that  
..updated commodity catalog information is written [to the writeable area of the medium] when provided by the server.

However Uranaka teaches that user purchase information may be written to the medium (C4, L18-34; C17, L17-31); he also teaches that his invention may determine whether catalog/product/guide information on the media is old when compared to the corresponding information on the server, and if the information on the medium is outdated, then new information will be transmitted from the server to the client for display (Fig 5, C10, L12-39).

Toyama discloses a system wherein an electronic catalog supplied on portable medium may be updated or revised by writing the new data onto the medium (Abstract).

Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have added this feature (suggested by Uranaka and disclosed by Toyama) to Uranaka's system, so that a user will always be assured of being able to browse, and review the most updated product/service information prior to purchase, starting from an published portable storage medium and then comparing with corresponding content stored on a remote server. Such a system would meet all the limitations of claims 1, 5, 16, 26, and 34.

As per claim 2.

Uranaka does not specifically disclose  
.. said read only area comprises  
a first area in which the original commodity catalog information as of a manufacture time of the medium is written, and  
a second area in which an encrypted key of a vendor is written.

However, as noted above for claims 1, 5, 16, 26, and 34, Uranaka teaches that his system will have the capability to determine whether content on the portable medium is old or current with content on the server (Fig 5, C10, L12-39). Therefore it is obvious that such determination inherently requires that a date of manufacture would need to be encoded on the medium.

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Also, Uranaka teaches that (1) the medium will have information uniquely identifying its origin (Fig 16: "DVD Identifying Information", "Title Information", "Issue Number Information", "Catalog Shopping Server Network Address", "Validity Check Value"; associated text); (2) that the medium would be uniquely certified and validated each time a request is made from the user to a server (same citations; C21, L18-22). While Uranaka does not go into the details of how all this certifying and validity checking is accomplished, it would have been obvious to one ordinarily skilled in the art at the time the invention was made that one method for accomplishing these checks would be to use a vendor encryption key encoded onto the medium. Such a method would meet the remaining limitation of claim 2, and would be motivated by the desire to prevent unauthorized use of the content of the medium or the server.

As per claims 3 and 11.

Uranaka in view of Toyama discloses all the limitations of claims 1 and 2 respectively.

Uranaka further discloses (see all above citations; Fig 16, associated text)

..said writeable area comprises [areas]

in which commodity purchase information is written (C4, L18-34), and  
for a user's private information (C4, L18-34).

Uranaka does not specifically disclose areas in which  
a commodity catalog information update date is written; or  
updated commodity catalog information is written.

Using the same obviousness and motivation analysis for claims 1, 5, 16, 26 and 34 above, it would have been obvious to one ordinarily skilled in the art at the time the invention was made that any updated catalog material would inherently need to be written onto a reserved writeable area of the medium, in order to provide the latest, locally stored catalog information for a user after each session with the server. Furthermore, it would have also been obvious that each such update would need to be date stamped, so that the system will know when subsequent updates would need to be written again.

As per claims 4 and 12.

Uranaka in view of Toyama discloses all the limitations of claims 3 and 11 respectively.

Uranaka further discloses (Fig 13, 16, associated text)

...said writeable area is an area in which predetermined information is repeatedly written by the server and a user.

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As per claims 6-8, 21.

Uranaka in view of Toyama discloses all the limitations of claims 5 and 19.

Uranaka further discloses

[claim 6] displaying the [updated] commodity catalog information (C19, L22-46).

Uranaka does not specifically disclose

[claim 7] catalog information is marked so that an updated portion and a non-updated portion are distinguished from each other.

[claim 8] the updated portion and the nonupdated portion are marked with different colors.

[claim 21] displaying both the existing and updated commodity catalog information such that the updated commodity catalog information is distinguishable from the existing commodity catalog information.

However Uranaka discloses that different display methods may be used for items ranked higher in terms of user preference – derived from past purchase history – than lower ranked products, and also for items that have already been purchased by the user in the past, versus items not yet ordered (C19, L26-33). Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made that one further display method difference, i.e. using different colors for new items compared to old ones, would have further enhanced the user's awareness of the new additions, thus potentially creating a desire to buy the new products. Such an added display method is consistent with Uranaka's teaching, and would anticipate claims 6-8 and 21.

As per claims 10, 19, 28.

Uranaka in view of Toyama discloses all the limitations of claims 5, 16, and 26 respectively.

Uranaka further discloses (see rejections of claims 1, 5, 16, 34 and claims 6-8, 21 above):

[claim 10] checking whether there is a commodity item to be updated/edited is performed through communication with the commodity information server.

[claim 19] the existing commodity catalog information has a corresponding age that is read from the medium, the updated commodity catalog information has a corresponding age that is read from the server, and said receiving the updated commodity catalog information comprises comparing the ages of the existing and updated commodity catalog information, and receiving the updated commodity catalog information where the ages are different.

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[claim 28] said checking comprises comparing a first age of the existing commodity catalog information on the medium with a second age of the updated commodity catalog information on the server, and said transmitting comprises transmitting the updated commodity catalog information when the second age is less than the first age.

As per **claims 9, 22-25, 27, 29-31.**

Uranaka in view of Toyama discloses all the limitations of claims 5, 16, 21, 26 and 28.

Uranaka further discloses all the following limitations (Fig 14, associated text; C20 L16 – C21 L3):

[claim 9] recording a purchase order based on the retrieval of the commodity catalog information from the medium.

[claim 22] making a purchase of a commodity using the existing and/or updated commodity catalog information.

[claim 23] receiving a purchase record from the server after said making the purchase, and writing the purchase record to the writeable area of the medium.

[claim 24] making a purchase of a commodity using the existing and/or updated commodity catalog information.

[claim 25] receiving a purchase record from the server after said making the purchase, and writing the purchase record to the writeable area of the medium.

[claim 27] receiving an order for a commodity based upon the existing commodity catalog information.

[claim 29] receiving an order for a commodity based upon the updated commodity catalog information.

[claim 30] receiving an order for a commodity based upon the combined existing and updated commodity catalog information.

[claim 31] transmitting a purchase record to be written on the medium.

As per **claims 13-14.**

Uranaka in view of Toyama discloses all the limitations of claim 1.

Uranaka further discloses

[claim 13] information is optically written (Fig 3, associated text).

[claim 14] information is magnetically written (Summary, C2, L23; C22 L62 – C23 L5).

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As per claims 15, 17-18, and 20.

Uranaka in view of Toyama discloses all the limitations of claims 1, 16, and 19.

Uranaka further discloses (Fig 16, associated text) that the catalog medium of his invention will have areas where information (original catalog data, media/vendor information) will be written once and readable-only thereafter; areas where information will be written over and over (new purchase orders, updated user information, purchase history). Taking in consideration the further need to write updated catalog data onto the medium as taught by Toyama, it would have been obvious to one ordinarily skilled in the art at the time the invention was made that the following limitations would all need to be met in Uranaka's invention in order to allow for the flexibility he discloses:

[claim 15] writeable area comprises an area to which information is written once, and is thereafter a read only area.

[claim 17] existing commodity catalog information is written in a read-only area of the medium.

[claim 18] existing commodity catalog information is written in a writeable area of the medium.

[claim 20] existing commodity catalog information comprises original commodity catalog information written in a read only area of the medium, and previously updated commodity catalog information written in a writeable area of the medium.

As per claims 32-33.

Uranaka in view of Toyama discloses all the limitations of claims 26 and 31.

Uranaka further discloses

receiving a password from the computer (C19, L47-57; Fig 14, associated text).

Uranaka does not specifically disclose

transmitting an encrypted key to the computer based upon the password.

However he does teach that the user needs to be uniquely certified before he can use the medium and the server, and that said certification will be based on the password chosen by the user (C19 L47 - C20 L7). The use of encrypted keys for such certification procedures is well known in the art, and therefore one ordinarily skilled in the art at the time the invention was made would have ensure that such keys are used in the invention, in order to provide strong security for transactions involving purchase orders and payments for those orders.



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As per claim 35.

Uranaka in view of Toyama discloses all the limitations of claim 34.

Uranaka further discloses

an electronic commerce server, the electronic commerce server to provide electronic commerce between said computer and said server during the purchase (Fig 12, associated text; C17 L17 - C18 L3),

Uranaka does not recite

an encryption server [with] encryption security device, to transmit an encrypted key to be written on the write area to be used if a commodity is purchased, the encryption security device and the encryption server to authenticate an identity of a user, and provide cryptographic communication between said computer and said server.

However, as analyzed in claim 33 above Uranaka does teach that the user needs to be uniquely certified before he can use the medium and the server (C19 L47 - C20 L7). The use of encrypted keys for such certification procedures is well known in the art, and therefore one ordinarily skilled in the art at the time the invention was made would have ensure that an encryption server with a security device would be included in the invention, so that cryptographic keys are used to authenticate and certify purchase orders, to prevent fraudulent use of the system.

As per claims 36-41.

Uranaka in view of Toyama discloses all the limitations of claim 35.

While Uranaka does not recite all the limitations of these claims, he clearly teaches that any well-known network and communication protocol may be used for his invention (C23 L3-5). Therefore Uranaka anticipates all the following claims:

[claim 36] the network comprises a wireless network.

[claim 37] the network comprises a network over the Internet.

[claim 38] the network comprises a local area network.

[claim 39] the network comprises a wide area network.

[claim 40] the network comprises an Ethernet network.

[claim 41] the network comprises a metropolitan area network.

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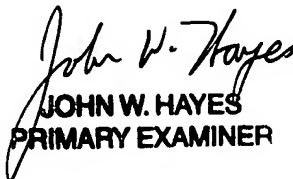
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Le whose telephone number is 703-305-4567. The examiner can normally be reached on 8:30am-5:30pm Mo-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-8494 for regular communications and 703-746-8494 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

DQL  
June 26, 2003

  
**JOHN W. HAYES**  
**PRIMARY EXAMINER**